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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,960	05/20/1999	JUNICHI IIDA	P17947	5852

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05/06/2004

GREENBLUM & BERNSTEIN PLC
1941 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 05/06/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,960

Applicant(s)

IIDA, JUNICHI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-63 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 and 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-31, 39-49 and 57-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 15/12-11-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/03 has been entered.

Response to Amendment

2. Applicant's amendment was received on 2/12/04, and has been entered and made of record. Currently, **claims 20-63** are pending, with **claims 32-38 and 50-56** being withdrawn from consideration as being drawn to a non-elected invention.

Response to Arguments

3. Applicant's arguments, see pages 12-18, filed 12/11/03, with respect to the rejection(s) of independent **claims 20 and 39** under 35 U.S.C. 102(e), being anticipated by Smith *et al.* (U.S. Patent Number 6,385,655), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Huang *et al.* (U.S. Patent Application Publication US 2003/0097361).

Information Disclosure Statement

4. The references listed in the Information Disclosure Statement submitted on 12/11/03 have been considered by the examiner (see attached PTO-1449).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 20-25, 27-31, 39-44, 46-49, and 57-63** are rejected under 35 U.S.C. 102(e) as being anticipated by Huang *et al.* (U.S. Patent Application Publication US 2003/0097361).

Regarding **claim 20**, Huang discloses a communication apparatus (site server 1030, seen in Figs. 10 and 23, paragraphs 0100-0102, and 0197) connected to a terminal apparatus (computer systems 1010a-n, see Figs. 9 and 10, paragraph 0100) via a network (Internet 1020), with the communication apparatus (site server 1030, seen in Figs. 10 and 23) comprising a control panel configured to at least enter a destination address (display screen 2320 and keyboard 2330, see Figs. 5A and 5B, paragraph 0073-0076), a memory that stores an address book including a plurality of destination addresses (paragraphs 0043-046, 0158-0159, and 0193, see Figs. 2D, 5A, and 5B), the address book being stored as a HTML file (paragraphs 0109, 0133, and 0190), a transmitter that transmits image data to a designated destination address which is stored in the address book (paragraphs 0072-0076), the image data being transmitted via *at least*

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one of the network or a telephone network (see Figs. 9 and 10) in response to an input from the control panel (see Figs. 5A and 5B, “send” button, paragraphs 0073-0074), a communicator that transmits the address book to the terminal apparatus when a request for the address book is received from the terminal apparatus (paragraphs 0072, 0107-0116, and seen in Figs. 11 and 18), the address book being displayable at the terminal apparatus (paragraphs 0113-0118), and a controller that, in response to an instruction from the terminal apparatus, transmits at least one input screen, associated with the address book (see Figs. 2D, 5A, and 5B, paragraphs 0113-0114), to the terminal apparatus, the input screen having an input field enabling modification of a destination address (see Figs. 2D, 5A and 5B, paragraphs 0074-0076, and 0168-0170), the screen configured so that the address book can be modified from the terminal apparatus (see Figs. 2D, 5A, and 5B, paragraphs 0074-0076, and 0168-0170).

Regarding **claim 21**, Huang discloses the apparatus discussed in claim 20 above, and further teaches that the controller deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (paragraphs 0126, 0138, 0193, see abstract, and Table 1 on page 17 under “addbooklist.asp”).

Regarding **claim 22**, Huang discloses the apparatus discussed in claim 20 above, and further teaches that the controller adds a destination address into the address book, in accordance with an instruction from the terminal apparatus (paragraphs 0076, and 0126, see Figs. 1B, 5A, 5B, and 8, and Table 1 on page 17 under “addbooklist.asp”).

Regarding **claim 23**, Huang discloses the apparatus discussed in claim 20 above, and further teaches that the controller edits a designated destination address in the address book, in

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accordance with an instruction from the terminal apparatus (paragraphs 0126, 0138, 0193, see abstract, and Table 1 on page 17 under “addbooklist.asp”).

Regarding **claim 24**, Huang discloses the apparatus discussed in claim 20 above, and further teaches that the address book includes telephone numbers as the destination addresses (see Fig. 5B, paragraphs 0071, 0076, 0087, 0098-0100).

Regarding **claim 25**, Huang discloses the apparatus discussed in claim 20 above, and further teaches that the address book includes e-mail addresses as the destination addresses (see Figs. 2D, 5A, and 5B).

Regarding **claim 27**, Huang discloses the apparatus discussed in claim 20 above, and further teaches of the communicator transmitting the address book and menu items to the terminal apparatus (see Figs. 5A, 5B, and 18, paragraphs 0113-0118), wherein the address book and the menu items are displayed as single image at the terminal apparatus (paragraphs 0113-0114, see Figs. 2D, 5A, and 5B), the menu items being utilized to change a content of the address book (see Fig. 2D, “edit” icon, and Figs. 5A and 5B, “new address”).

Regarding **claim 28**, Huang discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise an adding key that adds a destination address (Figs. 5A and 5B, “new address” key).

Regarding **claim 29**, Huang discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise a deleting key that deletes a destination address (see Fig. 11, “trash” icon 1148, paragraphs 0114 and 0168, and Table 1 on page 17 under “addbooklist.asp”).

Regarding **claim 30**, Huang discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise an edit key that instructs editing a destination address (see Fig. 2D, “edit” key).

Regarding **claim 31**, Huang discloses the apparatus discussed in claim 20 above, and further teaches that the terminal apparatus comprises a personal computer (see Figs. 9 and 10, paragraphs 0098-0100).

Regarding **claim 39**, Huang discloses a communication method using a communication apparatus (site server 1030, seen in Figs. 10 and 23, paragraphs 0100-0102, and 0197) connected to a terminal apparatus (computer systems 1010a-n, see Figs. 9 and 10, paragraph 0100) via a network (Internet 1020), the communication apparatus including a control panel (display screen 2320 and keyboard 2330, see Fig. 23), with the communication method comprising entering at least a destination address through the control panel (display screen 2320 and keyboard 2330, see Figs. 5A, 5B, and 23, paragraph 0073-0076), storing an address book including a plurality of destination addresses into a memory (paragraphs 0043-046, 0158-0159, and 0193, see Figs. 2D, 5A, and 5B), the address book being stored as a HTML file (paragraphs 0109, 0133, and 0190), transmitting image data to a designated destination address stored in the address book (paragraphs 0072-0076), the image data being transmitted via *at least one of* the network or a telephone network (see Figs. 9 and 10) in response to an input from the control panel (see Figs. 5A and 5B, “send” button, paragraphs 0073-0074), transmitting the address book to the terminal apparatus when a request for the address book is received from the terminal apparatus (paragraphs 0072, 0107-0116, and seen in Figs. 11 and 18), the address book being displayable at the terminal apparatus (paragraphs 0113-0118), and controlling, in response to an instruction

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from the terminal apparatus, transmission of at least one input screen associated with the address book (see Figs. 2D, 5A, and 5B, paragraphs 0113-0114), to the terminal apparatus, the input screen having an input field enabling modification of a destination address (see Figs. 2D, 5A and 5B, paragraphs 0074-0076, and 0168-0170), the input screen enabling modification of the address book from the terminal apparatus (see Figs. 2D, 5A, and 5B, paragraphs 0074-0076, and 0168-0170).

Regarding *claim 40*, Huang discloses the method discussed in claim 39 above, and further teaches that the controlling deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (paragraphs 0126, 0138, 0193, see abstract, and Table 1 on page 17 under “addbooklist.asp”).

Regarding *claim 41*, Huang discloses the method discussed in claim 39 above, and further teaches that the controlling adds a destination address into the address book, in accordance with an instruction from the terminal apparatus (paragraphs 0076, and 0126, see Figs. 1B, 5A, 5B, and 8, and Table 1 on page 17 under “addbooklist.asp”).

Regarding *claim 42*, Huang discloses the method discussed in claim 39 above, and further teaches that the controlling edits a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (paragraphs 0126, 0138, 0193, see abstract, and Table 1 on page 17 under “addbooklist.asp”).

Regarding *claim 43*, Huang discloses the method discussed in claim 39 above, and further teaches that the address book includes telephone numbers as the destination addresses (see Fig. 5B, paragraphs 0071, 0076, 0087, 0098-0100).

Regarding **claim 44**, Huang discloses the method discussed in claim 39 above, and further teaches that the address book includes e-mail addresses as the destination addresses (see Figs. 2D, 5A, and 5B).

Regarding **claim 46**, Huang discloses the method discussed in claim 39 above, and further teaches of transmitting the address book and menu items (see Figs. 5A, 5B, and 18, paragraphs 0113-0118), wherein the address book and the menu items are displayed as single image at the terminal apparatus (paragraphs 0113-0114, see Figs. 2D, 5A, and 5B), the menu items being utilized to change a content of the address book (see Fig. 2D, “edit” icon, and Figs. 5A and 5B, “new address”).

Regarding **claim 47**, Huang discloses the method discussed in claim 46 above, and further teaches that the menu items comprises adding a destination address (Figs. 5A and 5B, “new address” key).

Regarding **claim 48**, Huang discloses the method discussed in claim 46 above, and further teaches that the menu items comprises deleting a destination address (see Fig. 11, “trash” icon 1148, paragraphs 0114 and 0168, and Table 1 on page 17 under “addbooklist.asp”).

Regarding **claim 49**, Huang discloses the method discussed in claim 46 above, and further teaches that the menu items comprises editing a destination address (see Fig. 2D, “edit” key).

Regarding **claim 57**, Huang discloses the apparatus discussed above in claim 20, and further teaches that the controller modifies a designated destination address, in accordance with an instruction from the terminal apparatus (paragraphs 0126, 0138, 0193, see abstract, and Table 1 on page 17 under “addbooklist.asp”).

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Regarding *claims 58 and 59*, Huang discloses the apparatus and method discussed above in claims 20 and 39, respectively, and further teaches of providing a scanner and a printer in the communication apparatus (see Fig. 23, a scanning device and printer 2324, as read in paragraphs 0197-0198).

Regarding *claims 60 and 62*, Huang discloses the apparatus and method discussed above in claims 20 and 39, respectively, and further teaches of an input device configured to input data to the communication apparatus, the input device connected to the communication apparatus independently of a connection between the communication apparatus and the network (paragraphs 0197-0198, through a scanning device).

Regarding *claims 61 and 63*, Huang discloses the apparatus and method discussed above in claims 60 and 62, respectively, and further teaches that the input device comprises a scanner (scanning device, as read in paragraph 0198).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 26 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang *et al.* (U.S. Patent Application Publication US 2003/0097361) in view of Rachelson (U.S. Patent Number 6,157,706, cited in the Office action dated 8/12/03).

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Regarding *claims 26 and 45*, Huang discloses the apparatus and method discussed above in claims 20 and 39, respectively, but fails to specifically teach if the address book includes a destination name and a type of communication, of each destination address, the type of communication indicating one of a facsimile communication and an e-mail communication.

Rachelson discloses a communication apparatus (administrative site 100) connected to a terminal apparatus (facsimile machines 110 and computer 120) via a network (see Figs. 1, 4A-4C), with the communication apparatus comprising a memory (address book) that stores an address book including a plurality of destination addresses (see Figs. 9A, column 8, line 4 through column 9, line 35). Further, Rachelson teaches that the address book includes a destination name and a type of communication, of each destination address, the type of communication indicating one of a facsimile communication and an e-mail communication (see Fig. 9A, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

Huang & Rachelson are combinable because they are from the same field of endeavor, being systems that include address books.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings of Rachelson's address book in the system of Huang.

The suggestion/motivation for doing so would have been that Huang's system would become more user-friendly, as the modified address book would further allow the user to view and select telephone numbers and e-mail addresses as destinations, so as to indicate the type of communication, as recognized by Rachelson.

Therefore, it would have been obvious to combine the teachings of Rachelson with the system of Huang to obtain the invention as specified in claims 26 and 45.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp



EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600